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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,854	07/25/2001	Sachio Nagamitsu	MTS-3264US	6587

7590 05/17/2005

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EXAMINER	
BORISSOV, IGOR N	

ART UNIT	PAPER NUMBER
3639	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/912,854	NAGAMITSU ET AL.	
	Examiner	Art Unit	
	Igor Borissov	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *27-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *27-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 2/10/2005 has been entered.

Response to Amendment

Amendment received on 2/10/2005is acknowledged and entered. Claims 1-26 have previously been canceled. Claims 27 and 37 have been amended. New claims 45 and 46 have been added. Claims 27-46 are currently pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, new matter introduced into the claims and which is not supported by the specification is: *a third communication line which is a communication line separate from both the first communication line and the second communication line.*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim is 46 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 46 claims a program while reciting system elements, which is confusing. Furthermore, the examiner points out that claiming a program per se without reciting a computer-readable media could trigger a claim rejection under 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 27, 28, 31, 32, 37 43 45 and 46 **are rejected under 35 U.S.C. 103(a) as being unpatentable over Roos (US 5,699,276) in view of Johnson (US 6,169,979) and further in view of Hsu (US 6,374,079).**

Roos teaches a method and system for providing an interface between a digital network and home electronics, comprising:

As per claims 27, 37, 45 and 46.

Operating an appliance by a user (C. 7, L. 20-24);

measuring power consumption by a meter installed in the house of a user (C. 4, L. 10-22);

transmitting value of the energy consumed by the appliance from the meter to the energy provider via communication means (C. 4, L. 27-29);

charging the user for the energy consumed, thereby indicating accumulating the amount of energy consumed (C. 7, L. 2-5);

charging the user for said accumulated energy consumed a lower or higher fees (C. 7, L. 28-30).

Furthermore, Roos teaches that the communication means includes external power lines suspended by utility poles, power lines buried under ground, telephone lines, pre-existing coaxial cable and wireless communication means (C. 4, L. 2-5, 12-13, 47-48; C. 3, L. 29).

Roos does not specifically teach purchasing the appliance at a special price, wherein a part of the fee paid is allocated to the manufacturer that has sold said appliance. Roos also does not teach that said appliance is purchased through a web page of the appliance provider.

Johnson teaches a method and system for a computer-assisted sales system for utilities, wherein various fees are charged for power consumed, and wherein rebates are provided for purchasing or installation of more energy efficient equipment (C. 2, L. 49-51; C. 5, L. 1-24).

Hsu teaches a method and system for enabling data communication between service providers and customers, wherein the customers can purchase appliances directly via a provider's web page (C. 25, L. 51-54, 33-34; C. 26, L.42-54).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Roos to include purchasing the appliance at a special price, as disclosed in Johnson, because use of energy efficient appliances would result in reduction of energy consumption and utility cost.

And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Roos and Johnson to include purchasing appliances via a web page, as disclosed in Hsu, because it would advantageously allowed the customers with very little skill in the art to easily compare various types of the appliances, and choose and purchase the right equipment, as specifically stated in Hsu (C. 1, L. 51-53).

Information as to *a third communication line which is a communication line separate from both the first communication line and the second communication line* is given no patentable weight, because the specification does not provide any indication of advantages of using three separate communication line. Without providing such indication, it appears that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Roos, Johnson and Hsu to include multiple communication lines, because it has been held that that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claims 28 and 31. See reasoning applied to claims 27 and 37.

As per claim 32, Johnson teaches purchasing or installation more energy efficient equipment (C. 2, L. 49-51; C. 5, L. 1-24), thereby indicating operating the appliance in an energy saving mode. The motivation to combine Roos and Johnson would be stimulating a customer to reduce the energy consumption and utility cost.

As per claim 43, Roos teaches said method and system, comprising a display means installed in the home of said user, which receives said measurement information prepared by said automatic measurement means and which displays the fee (C. 5, L. 30-43).

Claims 29, 33-36, 38-42 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roos in view of Johnson further in view of Hsu and further in view of Yablonowski et al. (US 6,535,859).

As per claims 29, 33 and 39, Roos, Johnson and Hsu teach all the limitations of Claims 29, 33 and 39, except providing a portion of said charged fee to the installer of the power measurement unit/controller.

Yablonowski et al. teach a method and system for charging a fee to an end user, wherein a power saving device is retrofitted into a user's facility, and a portion of the charged fee is provided to an installer of the power measurement unit/controller (C. 7, L. 2 – C. 8, L. 65).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Roos, Johnson and Hsu to include that a portion of the calculated fee charged is provided to an installer of the power measurement unit, as disclosed in Yablonowski et al., because it would advantageously allow to pay installer for the job done.

As per claims 34-36 and 40-42, Roos, Johnson and Hsu teach all the limitations of claims 34-36 and 40-42, except that the additional fee is determined based on information concerning the degree of energy savings resulted from using said appliance.

Yablonowski et al. teach said method and system for charging a fee to an end user, wherein a power saving device is retrofitted into a user's facility, and fee charged are calculated as a function of a difference between the original power consumption and the new power consumption (column 7, line 2 – column 8, line 65).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Roos, Johnson and Hsu to include that the additional fee is determined based on information concerning the degree of energy savings resulted from using said appliance, as disclosed in Yablonowski et al., because it would advantageously stimulate a customer to reduce the energy consumption and utility cost.

As per claim 38, Yablonowski et al. teach said method and system, comprising a power management means for detecting that a user is utilizing said mode selectable apparatus in said special price mode (C. 9, L. 17).

Also, as per claim 44, Yablonowski et al. teach said method and system, comprising an energy saving control means for energy saving control based on human body detection (C. 6, L. 39-40).

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roos in view of Johnson further in view of Hsu and further in view of Hart et al. (US 4,858,141).

As per claim 30, Roos, Johnson and Hsu teach all the limitations of claim 30, except that measuring the value of the electric power consumed by said appliance is conducted separately from power consumed by other appliances.

Hart et al. teach a method and system for non-intrusive appliance monitoring apparatus, wherein the power consumption of each of a plurality of appliances is monitored separately from other appliances (C. 2, L. 15-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Roos, Johnson and Hsu to include separately measuring the value of the electric power consumed by said appliance, as disclosed in Hart et al., because it would advantageously allow to monitor and demonstrate the savings of power usage by new appliance, thereby convincing the purchaser to upgrade remaining appliances.

Response to Arguments

Applicant's arguments with respect to claims 1, 3-7 and 10-46 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (571) 272-6801.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (571) 272-6812.

Any response to this action should be mailed to:

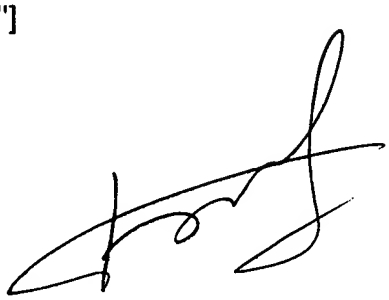
Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

Igor Borissov
Patent Examiner
Art Unit 3639



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5/4/2005